

**MEMO ENDORSED**

HON. VALERIE FIGUEREDO
UNITED STATES MAGISTRATE JUDGE

Dated: 12/5/24

Via ECF

The Honorable Andrew L. Carter Jr.
United States District Judge
U.S. District Court, Southern District of New York
40 Foley Square, Room 435
New York, NY 10007

The motion for Letters of Request is GRANTED.
Endorsed versions of Defendant's proposed Letters
of Request are attached to this memo endorsement.
The Clerk of Court is respectfully directed to
terminate the motion at ECF No. 87.

Re: *Deckers Outdoor Corp. v. Next Step Group, Inc.*, 1:23-cv-02545-ALC-VF

Dear Judge Carter:

We represent Defendant Next Step Group, Inc. ("Next Step"), and write to respectfully request three Letters of Request to obtain third-party discovery from three different Australian entities and their products. The entities and their products are Emu Australia and the Emu Australia Stinger Micro boot, UGG Since 1974 and the UGG Classic Ultra Mini boot, and UGG Australia and the Ugg Australia Classic Ultra Mini boot. We previously identified this potential need in the proposed Case Management Plan (D.I. 74 at 16).

These three different entities all sell footwear that is identical to that set forth in one of the Plaintiff's patents-in-suit (U.S. Patent No. D927,161) and trade dresses (Ugg Classic Ultra Mini). We have tried to obtain the discovery informally by contacting each of the entities but received no response. We also tried to obtain discovery from Plaintiff concerning the prior art footwear but received none, despite the fact that the three entities are Plaintiff's chief competitors whose products Plaintiff most likely tracks.

We also tried to rely on records from Amazon.com that show that the entities' products had been sold for years and are thus in the prior art, and from the internet archive, that also showed that at least one of the entities' products was published and sold for years and in the prior art, but the United States Patent and Trademark Office based on Plaintiff's objection rejected such proof.

Letters of Request are therefore our last recourse to prove that this prior art existed and provide a defense to Plaintiff's knowing assertion of invalid and unenforceable patents and trade dress.

In light of the above, Defendant Next Step respectfully attaches draft Letters of Request and requests that the Court grant their issuance.

Very truly yours,

/s/ Lee A. Goldberg

Lee A. Goldberg

encl.: Three draft Letters of Request
cc: Brent H. Blakely, Counsel for Plaintiff (via ECF)

LETTER OF REQUEST UNDER HAGUE EVIDENCE CONVENTION

Lee A. Goldberg (LG-9423)
Goldberg Cohen LLP
1350 Avenue of the Americas, 3rd Floor
New York, New York 10019
(646) 380-2087
LGoldberg@GoldbergCohen.com
Attorney for Defendant Next Step Group, Inc.

**IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF NEW YORK**

DECKERS OUTDOOR)	Case No. 1:23-cv-02545-ALC-VF
CORPORATION,)	
Plaintiff(s))	Request of International Judicial Assistance
v.)	(Hague Letter of Request)
)	
NEXT STEP GROUP, INC., et al.)	Hon. Valerie Figueredo
Defendant(s))	

The undersigned United States Magistrate Judge Valerie Figueredo respectfully requests you, the Private International and Commercial Law Section of the Attorney-General's Department of Australia, to cause the testimony and production of documents from Emu Australia, 72 Barwon Terrace, South Geelong, Victoria 3220, Australia, to be taken for use as evidence at trial in this matter, as more fully explained herein, pursuant to the provisions of the Hague Convention on the Taking of Evidence in Civil or Commercial Matters (Hague Evidence Convention).

Pursuant to Article 3 of the Hague Evidence Convention, the undersigned respectfully submits the following:

1. Sender: Lee A. Goldberg, Goldberg Cohen LLP, 1350 Avenue of the Americas, 3rd Floor, New York, New York 10019
2. Central Authority of the Requested State:

Private International and Commercial Law Section
Australian Government
Attorney-General's Department
Robert Garran Offices

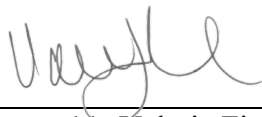
3-5 National Circuit
BARTON ACT 2600
Australia

3. Person to whom the executed request is to be returned: Lee A. Goldberg, Goldberg Cohen LLP, 1350 Avenue of the Americas, 3rd Floor, New York, New York 10019.
(LGoldberg@GoldbergCohen.com)
4. The date by which the requesting authority requires receipt of the response to the letter of request: January 20, 2025.
5. Requesting judicial authority (Article 3(a)): United States District Court for the Southern District of New York, Honorable Valerie Figueredo, United States Magistrate Judge, The Daniel Patrick Moynihan United States Courthouse, 500 Pearl Street, New York, New York 10007.
6. The competent authority requested to execute this letter of request: United States of America.
7. Case name(s) and identifying case number: *Deckers Outdoor Corporation v. Next Step Group, Inc.*, CA No. 1:23-cv-02545 (SDNY).
8. Names and addresses of the parties and their representatives (including representatives in the requested state) (if applicable) (Article 3(b)):
 - (a) Plaintiff: Deckers Outdoor Corporation, 250 Coromar Drive, Goleta, California 93117.
 - (b) Plaintiff's representative: Jamie Fountain, Blakely Law Group, 1334 Parkview Avenue, Suite 280, Manhattan Beach, California 90266.
 - (c) Defendant: Next Step Group, Inc., 681 Fifth Avenue, New York, New York 10022.
 - (d) Defendant's representative: Lee A. Goldberg, Goldberg Cohen LLP, 1350 Avenue of the Americas, 3rd Floor, New York, New York 10019.
 - (e) Other parties: Selim Dushey.
 - (f) Representative of other parties: Lee A. Goldberg, Goldberg Cohen LLP, 1350 Avenue of the Americas, 3rd Floor, New York, New York 10019.
9. Nature of the proceedings (Article 3(c)): Civil lawsuit for alleged patent and trade dress infringement and unfair competition concerning footwear, including whether the patents and trade dress are valid over the work of third parties, such as those of Emu Australia.
10. Specific evidence to be obtained or other judicial activity to be performed (Article 3(d)): The design, publication, public disclosure, advertising, and sale of the Emu Australia Stinger Micro boot, prior to November 8, 2018 and November 8, 2019, which will demonstrate the invalidity and unenforceability of a patent and trade dress that are in suit.

11. Identity and address of any person to be examined (Article 3(e)): A corporate representative of Emu Australia (at its address) including the President who is knowledgeable about the design, publication, public disclosure, advertising, and sale of the Emu Australia Stinger Micro boot, prior to November 8, 2018 and November 8, 2019.
12. The person(s) to be examined will be asked the following questions or will be examined on the following subjects (Article 3(f)): (a) the design, publication, public disclosure, advertising, and sale of the Emu Australia Stinger Micro boot, prior to November 8, 2018 and November 8, 2019; (b) any evidence of Deckers Outdoor Corporation's knowledge of such that it received from Emu Australia; and (c) identification of each of the documents that are requested and produced.
13. The following documents or other property will be inspected (if applicable) (Article 3(g)): documents sufficient to show (a) the design, publication, public disclosure, advertising, and sale of the Emu Australia Stinger Micro boot, prior to November 8, 2018 and November 8, 2019; and (b) documents that evidence Deckers Outdoor Corporation's knowledge of such that it received from Emu Australia.
14. The evidence must be given on oath (Article 3(h)).
15. The following special methods or procedures must be followed (if applicable) (Article 3(i), Article 9): a sworn deposition with oral examination and answers, providing for a transcript of the examination, and allowing for cross-examination.
16. It is requested that Lee A. Goldberg, Goldberg Cohen LLP, 1350 Avenue of the Americas, 3rd Floor, New York, New York 10019 (LGoldberg@GoldbergCohen.com) is notified of the time and place for the execution of this letter of request (Article 7) (if applicable).
17. Judicial personnel of the requesting authority may be present at the execution of this letter of request (Article 8) (if applicable): Not applicable at this time.
18. The person(s) to be examined has/have refused to give evidence based on the following privilege or duty under the law of the state of origin (if applicable) (Article 11(b)): Not applicable at this time.
19. All fees and costs incurred which are reimbursable under the second paragraph of Article 14 or under Article 26 of the Hague Evidence Convention will be borne by Next Step Group, Inc., 681 Fifth Avenue, New York, New York 10022. This United States District Court for the Southern District of New York will enforce any right you have to reimbursement.

The Honorable Valerie Figueredo, United States Magistrate Judge for the District Court for the Southern District of New York makes this letter of request this 5th day of December, 2024, at The Daniel Patrick Moynihan United States Courthouse, 500 Pearl Street, New York, New York 10007.

Letter of Request Emu Australia

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Honorable Valerie Figueredo
United States Magistrate Judge
Southern District of New York

LETTER OF REQUEST UNDER HAGUE EVIDENCE CONVENTION

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Plaintiff(s))	Request of International Judicial Assistance
v.)	(Hague Letter of Request)
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NEXT STEP GROUP, INC., et al.)	Hon. Valerie Figueredo
Defendant(s))	

The undersigned United States Magistrate Judge Valerie Figueredo respectfully requests you, the Private International and Commercial Law Section of the Attorney-General's Department of Australia, to cause the testimony and production of documents from Ugg Since 1974, 23 Christine Avenue, Miami QLD 4220, Australia, to be taken for use as evidence at trial in this matter, as more fully explained herein, pursuant to the provisions of the Hague Convention on the Taking of Evidence in Civil or Commercial Matters (Hague Evidence Convention).

Pursuant to Article 3 of the Hague Evidence Convention, the undersigned respectfully submits the following:

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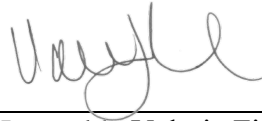
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 - (b) Plaintiff's representative: Jamie Fountain, Blakely Law Group, 1334 Parkview Avenue, Suite 280, Manhattan Beach, California 90266.
 - (c) Defendant: Next Step Group, Inc., 681 Fifth Avenue, New York, New York 10022
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10. Specific evidence to be obtained or other judicial activity to be performed (Article 3(d)): The design, publication, public disclosure, advertising, and sale of the Ugg Since 1974 Classic Ultra Mini boot, prior to November 8, 2018 and November 8, 2019, which will demonstrate the invalidity and unenforceability of a patent and trade dress that are in suit.

11. Identity and address of any person to be examined (Article 3(e)): A corporate representative of Ugg Since 1974 (at its address) including the President who is knowledgeable about the design, publication, public disclosure, advertising, and sale of the Ugg Since 1974 Classic Ultra Mini boot, prior to November 8, 2018 and November 8, 2019.
12. The person(s) to be examined will be asked the following questions or will be examined on the following subjects (Article 3(f)): (a) the design, publication, public disclosure, advertising, and sale of the Ugg Since 1974 Classic Ultra Mini boot, prior to November 8, 2018 and November 8, 2019; (b) any evidence of Deckers Outdoor Corporation's knowledge of such that it received from Ugg Since 1974; and (c) identification of each of the documents that are requested and produced.
13. The following documents or other property will be inspected (if applicable) (Article 3(g)): documents sufficient to show (a) the design, publication, public disclosure, advertising, and sale of the Ugg Since 1974 Ugg Classic Ultra Mini boot, prior to November 8, 2018 and November 8, 2019; and (b) documents that evidence Deckers Outdoor Corporation's knowledge of such that it received from Ugg Since 1974.
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The Honorable Valerie Figueredo, United States Magistrate Judge for the Southern District of New York makes this letter of request this 5th day of December, 2024, at The Daniel Patrick Moynihan United States Courthouse, 500 Pearl Street, New York, New York 10007.

Letter of Request UGG Since 1974

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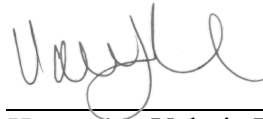
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